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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,802	06/30/2000	Martin Cieslak	CISCP146	2424
22434	7590	03/02/2006	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			BHATIA, AJAY M	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/608,802	CIESLAK ET AL.	
	Examiner	Art Unit	
	Ajay M. Bhatia	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19,40-57,78 and 80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19,40-57 and 78-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Examiner would like to note that applicant has only addressed double patenting rejection addressing patent 6,240,461 and 6,683,873 which terminal disclaimers were filed and accepted. But applicant has failed to address double patent with pending applications 09/608,548 and 09/527,085.

Applicant has amended claim 78 to included the term “tangible” to overcome the 101 rejection but this is not supported by the specification and therefore also fails written description. Additionally the mere inclusion of the term “tangible” does not overcome a 101 rejection, since the term fails to limit the claim to the statutory fields of invention.

In response to arguments addressing newly amended limitation examiner has addressed those features bellow. Therefore arguments addressing new features are moot. Since all other arguments were dependent upon the amendment they are also moot.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 78 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "tangible" is not supported by the specification, hence new matter, applicant is suggested to review the specification specifically page 25, to included terminology that is not new matter.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 78 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim discloses computer program product. The computer program product is not tangibly limited to a product that is within and enabled by the specification. Claim 78 is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 24, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., floppy disk) and intangible embodiments (e.g., carrier waves). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claims 1 and 80 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Because claims 1 and 80 fail to produce a useful, concrete and tangible result.

In *State Street*, the Federal Circuit examined some of its prior section 101 cases, observing that the claimed inventions in those cases were each for a “practical application of an abstract idea” because the elements of the invention operated to produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. For example, the court in *State Street* noted that the claimed invention in *Alappat* “constituted a practical application of an abstract idea (a mathematical algorithm, formula, or calculation), because it produced ‘a useful, concrete and tangible result’—the smooth waveform.” *Id.* Similarly, the claimed invention in *Arrhythmia* “constituted a practical application of an abstract idea (a mathematical algorithm, formula, or calculation), because it corresponded to a useful, concrete and tangible thing—the condition of a patient’s heart.” *Id.*

In determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result is “useful, tangible and concrete.” The Federal Circuit further ruled that it is of little relevance whether a claim is directed to a machine or process for the purpose of a § 101 analysis. *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1451.

A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases, a claim to a specific machine or manufacture will have a practical application. See *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (“the claimed invention as a whole is directed to a combination of interrelated elements which

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combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. This is not a disembodied mathematical concept which may be characterized as an 'abstract idea,' but rather a specific machine to produce a useful, concrete, and tangible

result."); and *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02 ("the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result' – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades."). Also see *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452 (Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held patentable subject matter because the process used the algorithm to produce a useful, concrete, tangible result without preempting other uses of the mathematical principle.).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19, 40-57, 78 and 80 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 09/608,548 and claims 1-6 of copending Application No. 09/527,085. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same subject matter. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19, 40-57, 78 and 80 are rejected under 35 U.S.C. 102(e) as being anticipated by Yates et al. ("Yates"), USPN 6,167,438.

Regarding claim 1, Yates discloses a method of facilitating redirection of traffic sent from a first processing device to a second processing device, the method comprising: at a third processing device associated with a plurality of traffic handling systems, receiving traffic information from each of the associated traffic handling systems, wherein the traffic information received from each associated traffic handling system specifies which data should be redirected to the each of associated traffic handling system [ie. router, Yates, col. 4, lines 40-59, col. 7, lines 28-56, col. 8, line 55 – col. 9, line 14, col. 12, lines 35-67 and col. 16, lines 35-37]; and determining how to redirect traffic received by the third processing device to a selected traffic handling system based on the received traffic information from each of the associated traffic handling systems[Yates, col. 7, lines 28-56, col. 8, line 55 – col. 9, line 14].

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Regarding claim 2, Yates further discloses wherein the determination of redirecting data is accomplished by: communicating the traffic information to at least a designated one of the associated traffic handling systems; and at the third processing device, receiving traffic redirection information from the designated traffic handling system, the traffic redirection information being based on the communicated traffic information [Yates, col. 8, line 55 – col. 9, line 14 and col. 12, lines 35-67].

Regarding claim 3, Yates further discloses at the third processing device, building or updating a data structure based on the received traffic information, wherein the traffic information is communicated to the designated traffic handling system within the data structure [Yates, col. 15, line 1 – col. 16, line 28].

Regarding claims 4-6 and 15, Yates further discloses in the third processing device, receiving a packet from the first processing device destined for the second processing device; and redirecting the packet to a selected one of the traffic handling systems based on the traffic redirection information, receiving the packet back after redirecting it to the selected traffic handling system [Yates, col. 4, lines 40-59, col. 7, lines 28-56, col. 8, line 55 – col. 9, line 14 and col. 12, lines 35-67]; determining that the packet is to be sent to the packet's original destination address instead of being redirected to the selected traffic handling system; and sending the packet to its original destination, wherein it is determined that the packet is to be sent to the packet's original destination by determining that the packet is encapsulated and de-encapsulating the packet prior to

sending the packet to its original destination and receiving a packet from the first processing device destined for the second processing device [Yates, col. 18, lines 21-43]; and when one or more port identifiers of the received packet matches a corresponding set field of the service options of the selected traffic handling system, redirecting the packet to the selected traffic handling system [Yates, col. 4, lines 40-59 and col. 12, lines 54-67].

Regarding claim 7, Yates further discloses the traffic information sent from a selected traffic handling system to the third processing device includes service options specifying which data is to be redirected to the selected traffic handling system [Yates, col. 8, line 55 – col. 9, line 14].

Regarding claim 8, Yates further discloses the service options include a plurality of fields that are configurable to indicate that one or more fields of a packet received in the third processing device are to be used to determined redirection of packets to the selected traffic handling system [Yates, col. 8, line 55 – col. 9, line 14].

Regarding claim 9, Yates further discloses the fields are selected from a group consisting of a source IP field, a destination IP field a source port field, a destination port field, a source IP alternative field, a destination IP alternative field, a source port alternative field, and a destination port alternative field [Yates, col. 12, lines 35-67].

Regarding claims 10 and 11, Yates further discloses each field indicates that a corresponding field of a packet received in the third processing device is to be used to generate an index to a table identifying the plurality of associated traffic handling systems, the generated index being associated with the selected traffic handling system, wherein each field indicates that a hashed value of the corresponding field of the received packet is to be used to generate the index to the table identifying the plurality of associated traffic handling systems [Yates, col. 15, line 1 – col. 16, line 28].

Regarding claim 12, Yates further discloses at least one of the fields may be set to indicate one or more port identifiers of traffic received in the third processing device [Yates, col. 15, line 1 – col. 16, line 28].

Regarding claims 13 and 14, Yates further discloses the fields are selected from a group consisting of a port fields, wherein the fields includes a source/destination field to indicate whether the port identifiers of the received traffic are source ports or destination ports [Yates, col. 12, lines 35-67].

Regarding claims 16-18, Yates further discloses the traffic information sent from a selected traffic handling system to the third processing device includes security options for specifying an authentication level for messages communicated between the third processing device and the selected traffic handling system, wherein the security options are configurable to select no authentication for messages communicated between the

third processing device and the selected traffic handling system and to require a predetermined password encoded within messages communicated between the third processing device and the selected traffic handling system [Yates, col. 4, line 60 – col. 5, lines 11].

Regarding claim 19, Yates further discloses the traffic information sent from a selected traffic handling system includes identifying information for the selected traffic handling system [Yates, col. 4, lines 1-26].

Regarding claims 40-57, 78 and 80, claims 40-57, 78 and 80 have similar limitations as claims 1-19. Therefore, the similar limitations are disclosed under Yates for the same reasons set forth in the rejection of claims 1-19 [Supra 1-19].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached UPSTO 892 (if appropriate).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Cardone
Supervisor Patent Examiner
Art Unit 2145

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